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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

Application Number: 08/626,600
Filing Date: April 02, 1996
Appellant(s): QUINN ET AL.

JUN 2 1 2007

GROUP 3600

George T. Marcou
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/29/07 appealing from the Office action

mailed 3/24/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2000-1442 mailed March 11, 2002 (re-mailed 10, 2002).

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,168,444	CUKOR ET AL.	12-1992
5,490,217	WANG ET AL.	2-1996
5,696,898	BAKER ET AL.	12-1997
5,644,778	BURKS ET AL.	07-1997
5,611,048	JACOBS ET AL.	03-1997

Dysart, J., "A Shortcut in the Paper Chase", Distribution, vol. 93, no. 1, January 1994, p. 42, 43.

Reding, T., "Digital Imaging Technology: What, Where and Why in Commercial Nuclear

Power", Nuclear Plant Journal, vol. 9, no. 4, July-August 1991, p. 89, 90 and 94.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Appellant's states that:

"Burks is directed to a system that receives medical claim data messages that arrive from

different healthcare providers in various formats (col. 5, line 66 - col. 6, line 5). Because the

incoming data is associated with data fields, data can be pulled from the messages and

reorganized into data fields of a generic format (col. 9, lines 31-35). The records are then stored

in a single database comprising of generic records. (col. 6, lines 15-23). Prior to forwarding a

particular medical record to an insurance company, the data can again be reorganized from its

generic state into a specified format of data fields stipulated by the particular insurance company

(col. 5, lines 48-65).

Contrary to the claimed invention, the system in Burks requires the incoming record to be

a data message and not an image so that the data can be extracted from particular data fields and

reorganized into a generic format. Neither Reding, Cukor, Jacobs, or Baker cure this or other

deficiencies of Burks.

For at least the reason stated above, the cited references do not teach or suggest

independent claims 44-46 of the present application.

Therefore, the undersigned respectfully submits that independent claims 44-46 are

allowable over the cited art.

Further, dependent claims 39-41 and 43 are also allowable as they contain the limitations

of the claims on which they depend. Therefore, the undersigned representative respectfully

requests that the Examiner withdraw the rejection of claims 39-41, 43, 44, 45, and 46. "

In response, from the above noted appellant's remarks, the appellant has merely

identified portions of the teachings of Burks et al. but failed to state how the claimed teachings

differ from the teachings of Burks et al. The appellant has failed to specifically point out how

the language of the claims patentably distinguishes them from the references.

Appellant is arguing the manner in which Burks et al format or reformat the received

medical data. However, when reviewing appellant's independent claims, the manner of in which

to format the image data or document is not being claimed. Thus, the manner in which Burks et

al. formats their information is irrelevant and should not be addressed.

Furthermore, the Examiner asserts that Burks et al clearly teach receiving medical data

such as medical claim data and remittance data from one health care provider in given format

and transmitting these medical data to another entity in another format as noted on column 5,

lines 15-65, column 8, lines 25-39 of Burks et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 39-41, 43, 44, 45 and 46 are rejected under 35 USC 103 as being

unpatentable over Cukor et al. (U.S. Patent No. 5,168,444) in view of Tom Reding,

"Digital Imaging Technology: What, Where, and Why in Commercial Nuclear Power',

Nuclear Plant Journal, July-August 1991, pages 89, 90, and 94 (hereinafter "Reding")

and Jacobs et al. (US Patent No. 5,611,048) or Baker et al (US Patent No. 5,696,898)

and Burks et al. (US Patent No. 5,644,778).

As per claims 44, 45 and 46, Cukor discloses a computer-based trade records

information management system for scanning, storing, searching, retrieving, and

displaying data pertaining to commercial transactions (see Cukor; abstract). A central

storage means at one or more regional processing centers stores bit mapped (scanned)

images of documents and includes a database of data related to the scanned documents (Fig. 1 ;

Col 5, lines 31 - 59., Col 8, lines 4 - 7). Cukor teaches regional processing centers comprised of a

plurality of customer workstations each located at shipping stations remote from a central storage

facility. Each workstation includes local storage means for storing bit mapped images and all

transaction-associated documents and information (Col. 7, lines 1 6 - 21 and Col 10, lines 22 -

40) and is linked to central storage by means of a local area network. Although Cukor does not

expressly disclose use of a wide area network for connecting the workstations to the regional

center nor for linking regional centers to each other, it does teach that a plurality of such regional

centers may be networked together over a large geographic area (Fig. 1 ; Col 5, line 31 - Col 6,

line 10).

Reding is a system for the electronic storage, management, and retrieval of all types of

documents and teaches that such a system can be implemented across both local and wide area

networks (Reding at page 89, column 1). Reding also teaches at page 89, column 2 that data

may be stored in ASC II format. It would have been obvious to one of ordinary skill in the art of

financial information management to modify Cukor with the wide area network means of Reding

in order to provide for institution-wide storage and retrieval of documents (see Reding at page

90, col. 3; Cukor at Col 5, lines 52 - 59).

Cukor also discloses means for inputting data into central storage from a plurality

of remote workstations and also from central means (Col 5, lines 43 - 50., Col. 7, lines 16 -21 ;

Col 8, lines 4 - 7, Col 10, lines 46 - 60).

Cukor teaches indexing data to be centrally stored by means of a common

PRO number and electronically associating all documents related to a single transaction

in a common electronic file folder for subsequent retrieval. Such indexed data includes at least

one scanned document (Col 2, lines 7 - 21 ; Col 10, lines 21 - 40).

Although Cukor does not expressly disclose the management of information

related to financial transactions, the Examiner asserts that the sale and shipment of goods is well

known to comprise financial transactions (see Col 1, line 65 to Col 2, line 6., Col. 6, lines 37 –

41). Cukor further discloses means for storing messages and completed inquiries (col. 14 - 27).

Furthermore, Cukor teaches electronic association of all documents associated with a particular

shipment transaction (Col 10, lines 22 - 40) and further discloses the processing of documents

for filling customer requests (Col 7, lines 21 - 25). The Examiner asserts that it would have

been obvious to one of ordinary skill in the art of financial information management to include

means for storing customer messages and inquiries. One would be motivated to do so in order to

retain all information related to a particular transaction in a single, searchable database for

subsequent review and/or retrieval and to avoid the problems associated with handling

paper documents (see Col 2, lines 7 - 12 and 19 - 21 ; Col 3, lines 21 - 25 and 62 - 65., Col. 5,

lines 21 - 25).

Although Cukor discloses means for searching data storage means and identifying found

records, it does not teach searching by means of structured inquiries (Col 8, line 65., Col 14,

lines 11 - 18., Col 7, lines 21 - 25). Reding does teach searching the document image file by

means of structured database queries and displaying the found records (page 89, col. 2). It would

have been obvious to one of ordinary skill in the art to modify Cukor with the structured query

means of Reding in order to utilize the sophisticated search means available through database

management systems (see Reding at page 89, col 2). Although both Cukor and Reding disclose

use of display means by which to view found documents, neither teach such means by which to

build structured queries. However, the Examiner asserts that the use of graphic user interfaces to

build structured queries is well known in the art of database management and would have been

obvious to the skilled artisan as a known and convenient means by which to search an online

database.

Cukor further discloses supervisory means for monitoring activities on the system (Col.

3, lines 31 – 34; Col 8, lines 48 – 49). Although Cukor does not disclose the details of the

supervisory means, the Examiner asserts that monitoring the work of another, any backlog of

processing, and assigning access privileges are all well known supervisory means and would

have been obvious to the skilled artisan to implement to ensure timely and secure processing of

financial data (see Col 3, lines 31 -32 and 35 - 36).

Cukor teaches accessing and displaying the data in a particular data folder (Col 1 4, lines

11 - 18., Col 7, lines 21 - 25).

Cukor teaches assigning a transaction data folder to a particular user by name, PRO

number, and/or bill of lading (Col 6, lines 49 - 60., Col . 10, lines 22 - 40).

Cukor discloses a work queue containing documents of a particular user to process (Col

7, lines 21 - 25).

Cukor teaches means for exchanging database data through the network (Col 7, lines 16 -

25).

Cukor teaches assignment of a unique internal identifier for the identification of each file

folder and further to identify each document image in the folder (Col 14, lines 8- 26; Col 15,

lines 2 - 8).

Cukor teaches a user having access to locally and regionally stored documents (Fig 1 ',

Col 29, lines 53 - 57., Col 7, lines 16 - 25). Cukor further discloses local access to the transaction

file when the regional center is unavailable (Col. 11, lines 1 - 8), regardless of why the regional center fails to respond.

As per the features of:

"means for restricting users to only retrieve images form the local storage means" of claim 44;

"restricting user workstations to only retrieve images from local storage devices" of claim 45; and

"wherein a system administrator may restrict the user to access only images from local storage devices" of claim 46.

The Examiner notes that functions of assigning and monitoring access privileges of a user or restricting users to only retrieve certain types of information from a particular storage device or on a network are well known in the art. Appellant is directed to column 4, line 7 to column 5, line 25 of Baker et al. and column 4, lines 39-65 of Jacobs et al.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of either Baker et al or Jacobs et al in the combination of Cukor and Reding in order to provide a security feature in the combination therein.

Appellant has amended:

the independent claim 44 to recite:

"means for storing images in a plurality of formats, wherein a first transaction data folder stores a first format of an image and a second transaction data folder stores a second format of the image"

independent claim 45 to recite: "wherein the image is stored in at least one format in the

transaction data folder". As per this limitation, the combination above teaches storing the

images. Images in a computerized system are usually stored in a given format. Storing such in a

transaction folder would have been obvious to one of ordinary skill in the art in the combination

above in order to relate images with a type of transaction.

Independent claim 46 to recite: "transmitting the at least one image in a second format

to a second regional processing center".

Furthermore, as per the above newly added features of claims 44-46, Burks et al teach a

medical transaction system wherein medical transaction data are formatted and stored in a

plurality of formats for transmitting to different types of entities. Each entity may be located in a

separate geographic location. Appellant is directed to the abstract and column 3, lines 1 to

column 4, line 36 and column 5, line 42 to column 6, line 23 of Burks et al. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to incorporate the

teachings of Burks et al into the above noted features above in order to allow different entities to

receive specific transaction with their desired formats as indicated by Burks et al. on columns 5

and 6.

As per claim 39, Cukor discloses communications between regional

processing centers for distributed image processing, including the retrieval of images

from transaction folders at one site from another site (Col 5, lines 43 - 59., Col 21, lines 42 - 45.,

Col 25, lines 40 - 44).

As per claims 40-41, Cukor's system provides for data input at local workstations

(column 10, lines 23-40).

Claims 37 and 42 are rejected under 35 USC 1 03 as being unpatentable over

Cukor, Reding and Baker et al or Jacobs et al. and Burks et al., as applied to Claim 46 above, and

further in view of Wang et al. (U.S. Patent No. 5,490,217).

As per Claims 37 and 42 and as discussed above regarding Claim 46, Cukor discloses a

computer-based trade records information management system for scanning, storing, searching,

retrieving, and displaying data pertaining to commercial transactions across a network of local

and regional stations. Although Cukor discloses the creation of transaction folders related to

financial transactions. The combination of Cukor, Reding and Baker et al or Jacobs et al. and

Burks et al does not expressly teach adding images to an existing folder nor transferring images

between folders. Wang is an automatic document handling system in which documents are

scanned into storage for archiving and subsequent retrieval (Wang at abstract; Col 2, lines 40 -

46). Wang teaches that images can be added to existing folders (Col 5, line 49 - 52) and may be

moved from one folder to another (col. 6. lines 27 - 31). Introducing the teaching of Wang et al

into the combination of Cukor, Reding and Baker et al or Jacobs et al. and Burks et al would

have been obvious to one of ordinary skill in the art at the time of the invention in order to move

files from one location or computer system to another location or computer system thus

providing instant and constant updates of data files or newly scanned documents.

Claim 38 is rejected under 35 USC 103 as being unpatentable over Cukor and

Reding, and Baker or Jacobs and Burks et al., as applied to Claim 46 above, and further

in view of Joe Dysart, &GA Shortcut in the Paper Chase", Distributing, v 93, n 1, pages

42 - 44, January 1994 (hereinafter "Dysart").

As per claim 38 and as discussed above regarding Claim 46 by Cukor, Reding, Baker or

Jacobs and Burks et al, Cukor further discloses a computer-based trade records information

management system for scanning, storing, searching, retrieving, and displaying data pertaining

to commercial transactions across a network of local and regional stations. Although Cukor

discloses local storage into transaction folders during the day (Col 6, lines 43 - 48), Cukor does

not expressly each that images are uploaded to the regional centers at night. Dysart teaches the

graphical images of financial documents across a network in which the scanned images are

transferred electronically to regional processing centers at night. Dysart at page 2, lines 3-7).

The motivation to combine Dysart with the teachings of Cukor and Reding, Baker or Jacobs and

Burks et al would be to take advantage of the well-known lower rates and lower traffic

associated with nightly electronic transmissions of data.

(10) Response to Argument

Appellant states that "Burks teaches taking an incoming data message (e.g., a claims

submission from a hospital) and editing and rearranging that data and generating a new and

different data message (e.g., one that satisfies the arrangement of data required by the insurance

company".

It does not contain new or additional information. The information contained before

formatting is the same as after formatting. The fact that the Burks extracts received data from

one message format to rearrange the extracted data in a new format acceptable by a different

recipient does not create a new document since all the information before and after formatting or

reformatting are the same. For example having a document in a WordPerfect X format and

reformatting the same document in a MS Word document does not create a new or unobvious

document. The contents are the same. Only the image format(s) are different. Data contents of

either of the documents are not altered or modified. Regarding the appellant's comments that

data when extracted creates a new and different data message is therefore not persuasive. Also

such a statement is not found in Burks in the manner that the appellant is arguing.

On column 5, lines 32-40, Burks state that the extracted data are only reorganized to

create in a new format. The data contents are not changed or modified.

Particularly, Burks states:

"In response to receipt of a medical claim from a healthcare provider station, medical transaction

system 10 reorganizes the information from the received medical claim into a generic medical

claim record format. These generic medical records may be stored in the memory of the medical

transaction system or organized in a generic transaction database 12 associated with the system.

The medical transaction system 10 may periodically extract generic medical records that

correspond to one of the trading partners. These extracted data records are formatted in a format

that corresponds to a computer identification code that corresponds to a trading partner.

Typically, the data message format for the formatted generic records are stipulated in a

contractual agreement between the operator of the medical transaction system and each of the

trading partners. The communication transmitter of the system 10 transmits, in the

communication protocol recognized by that trading partner, the formatted data messages to the

trading partner corresponding to the computer station identification code".

Appellant then argues that Burks does not teach or suggest an image is an image of a paper or hard-copy document and that image is either transmitted or stored in one or more different formats.

In response, Burks was not applied to denote teachings of an image being of a paper or hard-copy document. A paper or hard-copy document being scanned as an image file was noted to be taught by Cukor. Burks teaches techniques to manipulate image files from one format to another format as such was not explicitly taught by Cukor.

Steps or functions of scanning a document and storing the scanned document as an image file is taught by Cukor. Once being stored in memory, the image file can be manipulated and reformatted into one or more different formats for transmission to a desired recipient or location.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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